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In re Application of :
MUGNIER *et al* :
U.S. Application No.: 10/511,565 :
PCT No.: PCT/FR03/01197 :
Int. Filing Date: 15 April 2003 :
Priority Date: 17 April 2002 :
Attorney Docket No.: REGIM 3.3-040 :
For: METHOD FOR PRODUCTION OF A :
TUNABLE OPTICAL FILTER :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. 1.47(a)" filed 23 September 2005.

BACKGROUND

On 23 March 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an English translation, processing fee, oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 23 September 2005, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by three of the four joint inventors; a declaration of David Pureur ("Decl."); a four-month extension and fee, the \$130.00 processing fee, the \$65.00 surcharge fee and authorization to charge the petition fee to Deposit Account No. 12-1095.

DISCUSSION

In their response to the Form PCT/DO/EO/905, applicants claim that co-inventor, Rachelle Leroux, cannot be located after a diligent effort. Hence, a petition under 37 CFR 1.47(a) was submitted as part of the response.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. The petition fee has been charged to Deposit Account No. 12-1095 as authorized.

With regards to item (3), the last known address of co-inventor Rachelle Leroux is listed as:

No. 15 Bel Air
PLEUMEUR-GAUTIER
France-22740

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the four co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant included a declaration by David Pureur who stated that he has been unable to locate Ms. Leroux despite diligent efforts. Mr. Pureur wrote that "several attempts have been made to find the co-inventor Rachelle Leroux's current address and telephone number. In addition, we have tried to locate her at her last known address. We have also sent the declaration and other documents to her last known address, but these documents have been returned." Decl. at ¶ 4. No documentary evidence was provided.

Applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is

important that the statement contain facts as opposed to conclusions . . .

In this case, petitioners have not provided documentary evidence to substantiate their claim. For example, postal receipts for the document delivery to the nonsigning inventor's last known address was not provided. Moreover, the statement of facts does not provide the detail required by the MPEP. Petitioners must explain the steps taken to locate the nonsigning inventor and provide documentary evidence of any internet or telephone searches. In addition, Mr. Pureur has not indicated that he has the firsthand knowledge of the facts as required by the MPEP.

For these reasons, item (2) of 37 CFR 1.47(a) is not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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